

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed January 11, 2008. Claims 1-60 were pending in the Application. In the Office Action, Claims 1-60 were rejected. Claims 1-60 remain pending in the Application. Applicant respectfully requests reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

### **SECTION 103 REJECTIONS**

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.* Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Additionally, rejections based on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Teleflex Inc. v. KSR Int'l Co.*, 550 U.S. at 1, 82 USPQ2d at 1396 (2007). Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

### **Claims 1-11, 15-17, 19-23, 25-33, 36-40, 42-44, 46-48, 50-55, and 57-60**

Claims 1-11, 15-17, 19-23, 25-33, 36-40, 42-44, 46-48, 50-55, and 57-60 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0134650

issued to Sundar (hereinafter "*Sundar*") in view of U.S. Patent No. 7,024,218 issued to Bender et al. (hereinafter "*Bender*"). Applicant respectfully traverses this rejection.

Of the rejected Claims, Claims 1, 16, 26, 37, 42, 52, and 57 are independent. Applicant respectfully submits that the Examiner fails to establish a *prima facie* case of obviousness against independent Claims 1, 16, 26, 37, 42, 52, and 57 because one of ordinary skill in the art would not modify *Sundar* with the teachings of *Bender*. For example, the Examiner fails to establish a *prima facie* case of obviousness against Claim 1 because *Sundar* teaches away from the proposed combination. *Sundar* appears to disclose a method for internetworking between wireless local area networks (WLANs) and wireless wide area networks (WWANs) for voice communications with full mobility management across the two networks and the preservation of PBX features in the WWAN environment (*Sundar*, paragraph 0019). *Sundar* further appears to present that "the multimode mobile station is always attempting to stay connected to the macro network (CDMA, GSM, UMTS, etc.) (*Sundar*, paragraph 0063) (emphasis added). Therefore, *Sundar* appears to teach away from ever placing the multimode mobile station in transmit off mode because placing the multimode mobile station in a transmit off mode would render the multimode mobile station inoperable for its intended purpose of always staying connected to the macro network. Accordingly, the Examiner fails to establish a *prima facie* case of obviousness against independent Claim 1.

Further, the Examiner fails to establish a *prima facie* case of obviousness because the Examiner fails to present articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as required under *KSR*. The Examiner merely presents a conclusory statement that, "because *Sundar* teaches detecting wireless networks at least without transmitting probe request frames and modifying *Sundar* to include not transmitting anything would allow for an improved method for internetworking a mobile station to operate in WWAN and WLAN environments (see *Sundar* paragraph [0019]) (Office Action, page 5). The Examiner has not articulated any reason why modifying *Sundar* to include not transmitting anything would improve the internetworking of a mobile station to operate in WWAN and WLAN environments as disclosed by *Sundar*. As stated above, the modifications suggested by the Examiner appear to render *Sundar* inoperable for its intended purpose. Moreover, the Examiner cites to a portion of *Sundar* that states that there is a need for a method for internetworking between a wireless local area networks (WLANs) and wireless wide area

networks (WWANs) (*Sundar*, paragraph 0019). However, *Sundar* appears to fully address this need in the accompanying disclosure. Thus, the Examiner has not presented articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as to why one of ordinary skill in the art would be lead to combine the teachings of *Sundar* and *Bender*. Accordingly, the Examiner fails to present a *prima facie* case of obviousness against Claim 1.

The Examiner rejects independent Claims 16, 26, 37, 42, 52, and 57 using the same rationale as stated for Claim 1. For at least the same reasons as discussed above, the Examiner also fails to establish a *prima facie* case of obviousness against independent Claims 16, 26, 37, 42, 52, and 57. In addition, independent Claims 16, 26, 37, 42, 52, and 57 recite additional limitations not disclosed by the combination of *Sundar* and *Bender*. For example, the Examiner appears to admit that *Sundar* does not disclose or even suggest automatically switching a wireless device to a transmit off mode in response to activation of the wireless device," as recited in independent Claim 16 (Office Action, page 5) (emphasis added). The Examiner further states, "*Bender* teaches switching a device between a transmit on mode and a transmit off mode," (Office Action, page 5). However, the Examiner fails to establish that either reference discloses or even suggest automatically switching a wireless device to a transmit off mode in response to activation of the wireless device. Therefore, even if, *arguendo*, a reason exists to combine the teachings of *Sundar* with the teachings of *Bender*, which Applicant disagrees, the combination of *Sundar* and *Bender* fails to disclose or even suggest, "automatically switching a wireless device to a transmit off mode in response to activation of the wireless device," as recited in independent Claim 16 (emphasis added). Accordingly, the Examiner fails to establish a *prima facie* case of obviousness against Claim 16 for this additional reason.

Claims 2-11, 15, 17, 19-23, 25, 27-33, 36, 38-40, 43-44, 46-48, 50, 51, 53-55, and 58-60 depend respectively from independent Claims 1, 16, 26, 37, 42, 52, and 57. Therefore, for at least the reasons discussed above, the Examiner fails to establish a *prima facie* case of obviousness against Claims 2-11, 15, 17, 19-23, 25, 27-33, 36, 38-40, 43-44, 46-48, 50, 51, 53-55, and 58-60. Accordingly, Applicant respectfully requests the allowance of Claims 1-11, 15-17, 19-23, 25-33, 36-40, 42-44, 46-48, 50-55, and 57-60.

Claims 12-14, 18, 24, 34-35, 41, 45, 49, and 56

Claims 12-14, 18, 24, 34-35, 41, 49, and 56 were rejected under 35 USC §103(a) as being unpatentable over *Sundar* in view of *Bender* and in further view of U.S. Patent Publication No. 2004/0003285 issued to Whelan et al. (hereinafter "*Whelan*"). Claim 45 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Sundar* in view of *Bender* and U.S. Patent Publication No. 2004/0153676 issued to Krantz (hereinafter "*Krantz*"). Applicant respectfully traverses these rejections.

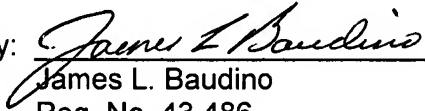
Claims 12-14, 18, 24, 34-35, 41, 45, 49, and 56 depend respectively from independent Claims 1, 16, 26, 37, 42, 52, and 57. Therefore, for at least the reasons presented above, the Examiner fails to establish a *prima facie* case of obviousness against Claims 12-14, 18, 24, 34-35, 41, 45, 49, and 56. Accordingly, Applicant respectfully requests the allowance of Claims 12-14, 18, 24, 34-35, 41, 45, 49, and 56.

**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

No fee is believed due with this Response. If, however, Applicant has overlooked the need for any fee due with this Response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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